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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
|---|-------------|----------------------|---------------------|------------------|
| 10/509,681 | 10/12/2004 | Hajime Kitano | 259279US0PCT | 3860 |
| 22850 | 7590 | 06/08/2006 | EXAMINER | |
| OBLON, SPIVAK, MCCLELLAND, MAIER & NEUSTADT, P.C. 1940 DUKE STREET ALEXANDRIA, VA 22314 | | | MULLIS, JEFFREY C | |
| | | | ART UNIT | PAPER NUMBER |

1711

DATE MAILED: 06/08/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Corrected

**Advisory Action
Before the Filing of an Appeal Brief**

Applicati n N .

10/509,681

Applicant(s)

KITANO ET AL.

Examiner

Jeffrey C. Mullis

Art Unit

1711

--The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

THE REPLY FILED 15 May 2006 FAILS TO PLACE THIS APPLICATION IN CONDITION FOR ALLOWANCE.

1. ☐ The reply was filed after a final rejection, but prior to or on the same day as filing a Notice of Appeal. To avoid abandonment of this application, applicant must timely file one of the following replies: (1) an amendment, affidavit, or other evidence, which places the application in condition for allowance; (2) a Notice of Appeal (with appeal fee) in compliance with 37 CFR 41.31; or (3) a Request for Continued Examination (RCE) in compliance with 37 CFR 1.114. The reply must be filed within one of the following time periods:

- a) ☒ The period for reply expires 3 months from the mailing date of the final rejection.
- b) ☐ The period for reply expires on: (1) the mailing date of this Advisory Action, or (2) the date set forth in the final rejection, whichever is later. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of the final rejection.

Examiner Note: If box 1 is checked, check either box (a) or (b). ONLY CHECK BOX (b) WHEN THE FIRST REPLY WAS FILED WITHIN TWO MONTHS OF THE FINAL REJECTION. See MPEP 706.07(f).

Extensions of time may be obtained under 37 CFR 1.136(a). The date on which the petition under 37 CFR 1.136(a) and the appropriate extension fee have been filed is the date for purposes of determining the period of extension and the corresponding amount of the fee. The appropriate extension fee under 37 CFR 1.17(a) is calculated from: (1) the expiration date of the shortened statutory period for reply originally set in the final Office action; or (2) as set forth in (b) above, if checked. Any reply received by the Office later than three months after the mailing date of the final rejection, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

NOTICE OF APPEAL

2. ☐ The Notice of Appeal was filed on _____. A brief in compliance with 37 CFR 41.37 must be filed within two months of the date of filing the Notice of Appeal (37 CFR 41.37(a)), or any extension thereof (37 CFR 41.37(e)), to avoid dismissal of the appeal. Since a Notice of Appeal has been filed, any reply must be filed within the time period set forth in 37 CFR 41.37(a).

AMENDMENTS

3. ☐ The proposed amendment(s) filed after a final rejection, but prior to the date of filing a brief, will not be entered because
- (a) ☐ They raise new issues that would require further consideration and/or search (see NOTE below);
- (b) ☐ They raise the issue of new matter (see NOTE below);
- (c) ☐ They are not deemed to place the application in better form for appeal by materially reducing or simplifying the issues for appeal; and/or
- (d) ☐ They present additional claims without canceling a corresponding number of finally rejected claims.

NOTE: _____. (See 37 CFR 1.116 and 41.33(a)).

4. ☐ The amendments are not in compliance with 37 CFR 1.121. See attached Notice of Non-Compliant Amendment (PTOL-324).
5. ☐ Applicant's reply has overcome the following rejection(s): _____.
6. ☐ Newly proposed or amended claim(s) _____ would be allowable if submitted in a separate, timely filed amendment canceling the non-allowable claim(s).
7. ☒ For purposes of appeal, the proposed amendment(s): a) ☐ will not be entered, or b) ☒ will be entered and an explanation of how the new or amended claims would be rejected is provided below or appended.
- The status of the claim(s) is (or will be) as follows:
- Claim(s) allowed: _____.
- Claim(s) objected to: 2, 3 and 11-20.
- Claim(s) rejected: 1 and 4-10.
- Claim(s) withdrawn from consideration: _____.

AFFIDAVIT OR OTHER EVIDENCE

8. ☐ The affidavit or other evidence filed after a final action, but before or on the date of filing a Notice of Appeal will not be entered because applicant failed to provide a showing of good and sufficient reasons why the affidavit or other evidence is necessary and was not earlier presented. See 37 CFR 1.116(e).
9. ☐ The affidavit or other evidence filed after the date of filing a Notice of Appeal, but prior to the date of filing a brief, will not be entered because the affidavit or other evidence failed to overcome all rejections under appeal and/or appellant fails to provide a showing a good and sufficient reasons why it is necessary and was not earlier presented. See 37 CFR 41.33(d)(1).
10. ☐ The affidavit or other evidence is entered. An explanation of the status of the claims after entry is below or attached.

REQUEST FOR RECONSIDERATION/OTHER

11. ☒ The request for reconsideration has been considered but does NOT place the application in condition for allowance because:
See Continuation Sheet.
12. ☐ Note the attached Information Disclosure Statement(s). (PTO/SB/08 or PTO-1449) Paper No(s). _____
13. ☒ Other: Interview summary.

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Art Unit: 1711

Continuation of 11. does NOT place the application in condition for allowance because: Applicants argue that the secondary references contain disclosures re monohydroxylated diene polymers as well as other disclosures. However, unless the "other disclosures" of the prior art would lead those skilled in the art away from the claimed invention the nature of the other disclosures is immaterial. The secondary references have been used for their disclosure of the low cost benefit of use of butadiene and the other disclosures of the secondary references do not effect the motivation to lower cost in the primary reference. It is true that some picking and choosing is needed to arrive at applicants invention based on the primary reference but such picking and choosing is acceptable so long, as in the instant case it is not excessive. With re to applicants molecular weight, the difference between weight an number average molecular weight in Hiro is very small as set out in paragraph 61 of the patent as is expected for living polymerizations and applicants and patentees range of molecular weights overlap. It is assumed that the genus of diene monomers do function and is an example of monomers which do not spoil engine performance since patentees has specifically disclosed the use of dienes. Dienes are a member of the group that includes specific species such as beta pinene and it not clear why beta pinene would be named if it didn't work as choice of a specific species based on disclosure of beta pinene is not possible as it is a species not a genus. However even assuming the examiner is incorrect and patentees are implying that the named genus "diene" may or may not work it would reasonably appear that it would work given that it is a hydrocarbon monomer as are the monomers named by patentees that are disclosed as workable. In any case absolute predictability is not needed when making a proposed modification in a rejection under 35 USC 103. Only a reasonable expectation of success is. The motivation to use butadiene is that such usage would reduce the cost per pound of the final product, an advantage. Applicants admission on page 9 that it was known at the time of the invention to make laminates for use as automobile parts is motivation to make laminates from patentees materials as patentees' goal is to make articles used in the automotive field and thus production of laminates would therefore help meet a goal of the primary reference.

Jeffrey Mullis
Primary Examiner
Art Unit 1711

